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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/645,833 | 08/20/2003 | Grzegorz J. Kusinski | 020030-000910US | 7656 |

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EXAMINER

YEE, DEBORAH

ART UNIT PAPER NUMBER

1742

DATE MAILED: 10/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/645,833

Applicant(s)

KUSINSKI ET AL.

Examiner

Deborah Yee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 to 15, 20 and 21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 20 of U.S. Patent No. 6,273,968. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the same reasons set in the 103 rejection based on US Patent 6,273,968 in the office action dated June 8, 2005.

3. Claims 1 to 10, 16 to 19, 20 and 21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 3 of U.S. Patent No. 4,619,714. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the same reasons set forth in the 103 rejection based on US Patent 4,619,714 in the office action dated June 8, 2005.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 to 15, 20 and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (US Patent 6,273,968) for the reasons set forth in the previous office action dated June 8, 2005.

3. Claims 1 to 10, 16 to 19, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (US Patent 4,619,714) for the reasons set forth in the previous office action dated June 8, 2005.

Response to Arguments

4. Applicant's arguments filed 8-18-05 have been fully considered but they are not persuasive. It was submitted that Thomas '968 discloses the alloy microstructure that is the subject of the present application but Thomas'968 does not disclose how to perform cold working other than by the conventional process comprising cold working with the intermediate heat treatment of patenting. It is the examiner's position that Thomas'968 teaches processing steel alloy by cold forming to achieve high tensile strength without any intermediate heat treatment step. See Thomas '968 on lines 1 to 7 of column 6 discloses his "carbon steel useful in products that require high tensile strengths and are

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manufactured by processes involving cold forming operation since the microstructure of the alloys lends itself particularly well to cold forming. Examples of such products are sheet metal for automobiles and wire or rods such as for radially reinforced tires."

Based on this disclosure there is no suggestion that Thomas'968 alloy is processed by the conventional process of cold working with intermediate patenting. Moreover the conventional wire/rod process suggested by applicant is directed to pearlitic microstructures and hence would not apply to the Thomas'968 alloy which has a microstructure of martensite lathes alternating with films of retained austenite.

5. It was submitted that Thomas'714 steel contains a matrix of fine-grained ferrite with a dispersed second phase such as lath martensite, bainite and/or austenite whereas the present invention is directed to a matrix of martensite with the austenite present only in the form of thin films between the martensite laths. It is the examiner's position that even though Thomas'714 steel additionally contains ferrite, such would not be excluded from applicant's claim 1 reciting "a microstructure comprising". Note that the transitional phrase "comprising" is inclusive of all unrecited microstructural phases. To distinguish claims over prior art, it is recommended to use language in claim 1 such as ---steel alloy having a microstructural matrix consisting of laths of martensite alternating with thin films of from about 0.50 to about 15% by volume of retained austenite .

6. Moreover, prior art ferrite would not be excluded from claim 16. Note that claim 16 actively recites the presence of ferrite since step (iii) forms a ferrite-austenite phase

and step (iv) cools to only converts austenite to laths of martensite with films of retained austenite, and ferrite remains present.

7. Even though prior art does not teach volume per of retained austenite as recited by claims 1, 20 and 21, such would be expected since composition, microstructure and process limitations are closely met, and in absence of proof to the contrary.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

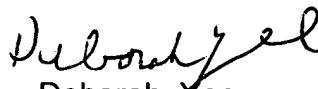
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is 571-272-1253. The examiner can normally be reached on Monday-Friday from 6:00 to 3:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Deborah Lee
Primary Examiner
Art Unit 1742

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